

Application No. 09/456,429
Attorney's Docket No. P-015-RP1
Page 8

III. REMARKS

Applicants submit that the present amendments, which adopt the suggestions by the Examiner, require only a cursory review by the Examiner and place the claims in condition for allowance. The presented amendments do not change the scope of the invention; nor do they require a new search. Thus the amendments do not put an undue burden upon the examiner. Accordingly, entry of these amendments after final rejection is respectfully requested.

1. Status of the Claims

Claims 74-83 are pending in the application. Applicants have canceled Claims 74-79 and 81, and amended Claims 80, 82 and 83. Accordingly, upon entry of the above amendments, Claims 80, 82 and 83 are pending in this application.

2. Amendments to the Claims

Claims 74-79, and 81 have been canceled. Applicants reserve the right to pursue these claims in continuation or divisional applications.

Claim 80, which had been objected to as being dependent upon canceled claim 69, and which the Examiner indicated would be allowable if rewritten as an independent claim, has been amended to be in independent form including all of the limitations of the base claim, Claim 74.

Claim 82, which had been objected to as being dependent upon canceled claim 69, and which the Examiner indicated would be allowable if the dependency was corrected, has been amended to depend from Claim 80.

Claim 83, which claims a pharmaceutical composition, has been amended to depend from Claims 80 and 82.

No new matter has been added.

Entry of these amendments is earnestly solicited.

3. Claim Objections

In the October 8, 2003 Final Office Action, the Examiner objected to Claims 78 and 80-82 because the claims depended from canceled Claim 69. This was a typographical error, and the

Application No. 09/456,429
Attorney's Docket No. P-015-RP1
Page 9

claims should have depended from independent Claim 74. Applicants have canceled Claims 78 and 81, amended Claim 80 to be an independent claim, and amended Claim 82 to depend from Claim 80.

Accordingly, Applicants respectfully request that the objection to Claims 80 and 82 be removed.

4. Rejections under 35 U.S.C. 102(e) or in the alternative, under 35 U.S.C. 103(a)

In the October 8, 2003 Final Office Action, the Examiner (i) rejected Claims 74 and 83 under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Leung-Toung et al. (US 5,723,618); and (ii) rejected Claims 74, 78, 81 and 83 under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over either of Yamamori et al. (US 5,378,698) or Yamamori et al. (US 5,462,936).

In order to expedite the allowance of material that the Examiner has indicated would be allowable, Applicants have canceled Claims 74, 78, and 81, and the rejection against these claims is therefore moot.

Claim 83 is to a pharmaceutical composition, and was rejected because the compound claims it depended from were rejected by the Examiner. Claim 83 has been amended to depend from Claims 80 and 82, compound claims that the Examiner has indicated would be considered allowable. Therefore a pharmaceutical composition using those compounds would not be anticipated or obvious.

For at least these reasons, Applicants respectfully request that the rejections of Claim 83 be withdrawn.

4. Allowable Subject Matter

In the October 8, 2003 Final Office Action, the Examiner indicated that "Claims 80 and 82 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitation of the base claim and any intervening claims."

In order to expedite the issuance of claims that the Examiner indicated would be allowable, Applicants respectfully request that the above amendments be entered.

Application No. 09/456,429
Attorney's Docket No. P-015-RP1
Page 10

Applicants submit that the amendments presented herein put pending Claims 80, 82 and 83 in condition for allowance.

Should there be any remaining issues that can be resolved by telephone, the Examiner is respectfully requested to telephone the undersigned agent at (650) 808-6144.

Respectfully submitted,
THERAVANCE, INC.

Date: Feb 25, 2004

Joyce Cohen
Joyce Cohen, Reg. No. 44,622

THERAVANCE, INC.
Attn: Legal Dept.
901 Gateway Boulevard
South San Francisco, CA 94080
Tel: (650) 808-6000
Fax: (650) 808-6078